



AF

Patent
Attorney Docket No. 81745
Customer No. 23685

TRANSMITTAL LETTER

Inventor: Michael S.H. Chu et al.
Serial No: 10/037,807
Filed: December 26, 2001
For: LOW PROFILE ADAPTOR FOR USE WITH A MEDICAL CATHETER

Examiner: Sharon E. Kennedy
Group Art Unit: 3762
Confirmation No: 6255

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith for the above-identified patent application are the following:

A Proposed Amendment After Final Rejection
A Request to Withdraw the Finality of an Office Action
A return postcard

The item(s) checked below are appropriate:

- an
1. ___ Applicant(s) hereby petition(s) for a () month extension of time to respond to
 1755. 2. ☒ Please charge any fees or costs not accounted for to Deposit Account No. 11-
 3. ___ Applicant is a small entity.

Date: June 14, 2005


Edward M. Kriegsmann
Reg. No. 33,529

KRIEGSMAN & KRIEGSMAN
665 Franklin Street
Framingham, MA 01702
(508) 879-3500

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 14, 2005.


Edward M. Kriegsmann



PATENT
Attorney Docket No. 81745
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
MICHAEL S.H. CHU ET AL.)	
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Serial No.: 10/037,807)	Group Art Unit: 3762
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USE WITH A MEDICAL)	
CATHETER)	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST TO WITHDRAW THE FINALITY OF AN OFFICE ACTION

Applicants respectfully request reconsideration and withdrawal of the finality of the Office Action dated March 14, 2005, in the above-identified patent application.

This request is not to be considered responsive as a reply under either 37 C.F.R. § 1.111 or 37 C.F.R. § 1.116 to the Office Action dated March 14, 2005.

The present Office Action is the second action on the merits in this case and the third action overall in this case. A written restriction requirement was mailed by the Patent Office on August 16, 2004, and Applicants filed a response to the same on September 16, 2004.

The Patent Office Action then mailed a first Office Action on the merits on December 1, 2004. In said December 1, 2004 Office Action, the Patent Office (i) withdrew claims 4, 12, 16, 29, 32 and 33 from further consideration, (ii) rejected claims 1-3, 5-10, 17-24, 27-28, 30-31 and 34-35 “under 35 U.S.C. 102(b) as being clearly anticipated by Kelliher et al., US 5,836,924,” (iii) rejected claims 11, 13-15 and 36-38 “under 35 U.S.C. 103(a) as being unpatentable over Kelliher ‘924 as applied to claim 10 above, and further in view of Delegge, WO 02/13901,” and (iv) rejected claims 25 and 26 “under 35 U.S.C. 103(a) as being unpatentable over Kelliher ‘924 as applied to claim 5 above, and further in view of Shmulewitz et al., US 6,569,145.”

On February 21, 2005, Applicants filed a response to the December 1, 2004 Office Action. In said response, Applicants, among other things, (i) canceled claim 20, which had read “[t]he adaptor as claimed in claim 5 wherein said second channel has a front end and a rear end, said front end of said stem being spaced rearwardly from said front end of said second channel” and (ii) amended claim 5 as follows:

5. An adaptor well-suited for use with a medical catheter, said adaptor comprising:

(a) a body, said body being provided with a first channel and a second channel, said first channel and said second channel being in fluid communication with one another, said first channel being adapted for fluid communication with the medical catheter, said second channel having a front end; and

(b) a stem, said stem having a front, a rear, a side wall, a cavity extending rearwardly from said front end, and a hole in said side wall in fluid communication with said cavity, said stem being mounted within said second channel of said body and with said front end of said stem being spaced rearwardly from said front end of said second channel, said stem being rotatable between an open position in which said stem and said first channel are in fluid communication with one another via said hole and a closed position in which said stem and said first channel are not in fluid communication with one another.

In the outstanding Office Action of March 14, 2005 (the second Office Action on the merits), the Patent Office, among other things, rejects claims 5-10, 17-24¹, 27-28, 30 and 34-35 “under § 103(a) as being unpatentable over Kelliher ‘924 in view of Dennehey et al., US 4,417,890.” In support of making the outstanding Office Action a final action, the Patent Office states that “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action.”

The Manual of Patent Examining Procedure at § 706.07(a) clearly provides as follows:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)....

Applicants respectfully traverse the propriety of the finality of the present Office Action for at least the reason that the final rejection of claim 5 was neither necessitated by amendment nor based on an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). Therefore, the finality of the present Office Action is improper and should be withdrawn.

More specifically, Applicants note that, in the first Office Action on the merits, claims 5 and 20 were rejected under 35 U.S.C. 102(b) for allegedly being anticipated by Kelliher et al. but that, in the present Office Action, claim 5 stands rejected under 35 U.S.C. 103(a) for allegedly being unpatentable over Kelliher et al. in view of Dennehey et al. As pointed out above, claim 5 was amended in the February 21, 2005 Amendment to include all of the limitations of canceled claim 20, except for the recitation that the second channel has a rear end. The same rationale used by the Patent Office in the present Office Action to reject claim 5 under 35 U.S.C. 103(a) over Kelliher et

¹ The inclusion of claim 20 in the statement of the rejection is apparently a clerical error since claim 20 was canceled in the Amendment of February 21, 2005.

al. in view of Dennehey et al. could have been applied, but was not applied, to reject claim 20 in the first Office Action on the merits. Consequently, it cannot be said that the amendment of claim 5 in the February 21, 2005 Amendment necessitated the present rejection.

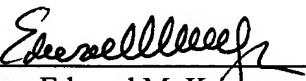
Applicants should be given a full and fair opportunity to respond to the new rejections without being restricted to the requirements of 37 C.F.R. § 116. In view of the above, it is respectfully submitted that the finality of the Office Action dated March 14, 2005 is premature and should be withdrawn.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is

required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

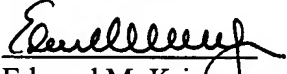
Respectfully submitted,

Kriegsman & Kriegsman

By: 
Edward M. Kriegsman
Reg. No. 33,529
665 Franklin Street
Framingham, MA 01702
(508) 879-3500

Dated: June 14, 2005

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Edward M. Kriegsman
Reg. No. 33,529
Dated: June 14, 2005